

### **REMARKS**

Claims 1-17 are pending.

The Examiner's indication that claims 5, 6, 13 and 14 would be allowable if rewritten in independent form is noted with appreciation. Claim 5 has been amended to include the limitations of former independent claim 2. Claim 13 has been amended to include the limitations of former independent claim 1.

Claim 1 was rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,644,173 to Lazaris et al. As set forth in the previous Amendment, Lazaris does not disclose first and second piercing elements formed as a single removable unit that is unattached to the beverage preparation machine, but instead discloses that its platen 40 carrying the probes 42 and 44 is shifted between a retracted and an advanced position by a pneumatic cylinder 46.

In describing Lazaris, the Office action, p. 2, states that its "piercing elements are attached to a moveable element no attached to the cartridge holder of the beverage preparation machine." Claim 1 does not state that the first and second piercing elements are unattached to a cartridge holder. Instead, claim 1 states that they are "unattached to the beverage preparation machine." Lazaris makes clear that its probes 42 and 44 are part of an attached to its beverage cartridge holder. The Summary of the Invention of Lazaris states that it "has as its principle objective the provision of a modified beverage filter cartridge holder **incorporating** inlet and outlet probes..." (Col. 1, ll. 65-67 (emphasis added).) Lazaris also describes that "heated liquid...is admitted...into cartridge chamber A via the inlet probes." (Col. 3, ll. 25-27.) Further, Lazaris' claim 1 recites a "holder comprising...a platen; inlet and outlet probes carried by said platen." Thus, the platen 40 and inlet and outlet probes 42 and 44 of Lazaris are part of its cartridge holder and are attached to the cartridge holder, see, i.e., Fig. 4.

Claims 2-4, 7-12, 15 and 16 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lazaris in view of U.S. Patent No. 5,794,519 to Fischer. As set forth in the prior Amendment, the Office action fails to identify any motivation in either reference for their proposed combination, and such motivation is not present because the disclosures of both Fischer and Lazaris teach away from such a combination. Fischer discloses a capsule that is pierced from opposite sides. In

Application No. 10/763,928  
Amendment dated October 19, 2006  
Reply to the Office action of May 19, 2006

contrast, Lazaris describes cartridges that are pierced in opposite directions as having certain problems and disadvantages. (Col. 1, ll. 29-55.)

For the reasons set forth above, claims 1-16 are believed to be allowable, and reconsideration and allowance of claims 1-16 are respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required in this application to Deposit Account No. 06-1135.

Respectfully submitted,

FITCH, EVEN, TABIN & FLANNERY

Date: October 19, 2006

s/Jon A. Birmingham/

Jon A. Birmingham

Registration No. 51,222

FITCH, EVEN, TABIN & FLANNERY  
120 S. LaSalle Street, Suite 1600  
Chicago, Illinois 60603-3406  
Telephone: 312.577.7000  
Facsimile: 312.577.7007

453680